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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,833	12/29/2000	Don Eden Hale	10010039-1	9194

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AGILENT TECHNOLOGIES  
Legal Department, 51U-PD  
Intellectual Property Administration  
P.O. Box 58043  
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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/750,833

**Applicant(s)**

HALE ET AL.

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Amendment***

The amendment filed 7/1/2004 has been entered.

### ***Terminal Disclaimer***

1. The Terminal Disclaimer filed 7/1/2004 is improper because: (1) fees has not been paid and (2) the application/patent being disclaimed has been improperly identified since the number used to identify the co-pending application, no. 10/177,471 being disclaimed is incorrect. The correct number is 10/117,471.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 1-10, 11-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 11-20 of copending Application No. 10/117,471.** Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1 and 7 (or 11 and 17) of this application reads over claim 1 (or 11) of copending Application

No. 10/117,471. As for the limitation of "facilitating the financial transaction", it's inherently included when combining claims 1 and 7 (or 11 and 17) or would have been obvious in view of the general teaching of virtual integration of the business model.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 101***

The rejections of claims 1-10, 11-20 are under 35 U.S.C. 101 are withdrawn due to amendment of 7/1/2004.

***Claim Rejections - 35 USC § 112***

The rejections of claims 11-20 under 35 U.S.C. 112, second paragraph, are withdrawn due to amendment of 7/1/2004.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. **Claims 1-10, 11-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over VAN HOEK (Article "Logistics and virtual.... Information", 1998).**

**As for independent claims 1 (method<sup>1</sup>), 11, VAN HOEK discloses a computed-implemented method of using a business model of virtual integration to transact business process for a product comprising the steps of:**

(a) providing a plurality of virtual alliances for the manufacture and distribution of the product (**seamless** integration of the supply chain or functions and large numbers of (outside: outsourcing and sub-contracting) companies involved (with Dell Computers), outsourcing, partnering and co-operation among various players),

(b) providing a plurality of virtual flows for enabling electronic communication between the plurality of virtual alliances for use in the manufacture and distribution of the product (linking up the chain of information flows, entire chain, i.e. purchasing, manufacturing and shipment, of connectivity in the flow of information) to allow seamless integration of the chain via information flow (see 1<sup>st</sup> page, bottom part),... a seamless integration of functions and the large number of (outside) companies involved in the physical sphere.... The company achieves control ... by mastering the flow of information (see page 2, 1<sup>st</sup> paragraph), ... integration and control is not based on direct ownership but rather on connectivity in the flow of information (see page 2, 3<sup>rd</sup> paragraph);

(c) providing a contracting business (main company entity) for coordination among the virtual alliances, and

(d) using the main company entity to establish, via the virtual flows, control over the manufacture and distribution of the product by the plurality of the virtual alliances (see pages 1, 2, 3, 8, 9, especially page 8, lines 32-40, which teaches "MCC, the OEM in this case, maintains control over the supply chain by controlling and integrating the flow of information). As for the amended language of "the virtual flows having access to the virtual alliances at each stage of the manufacture and distribution of the product, this is inherently included in the teachings as mentioned in (b) to achieve seamless integration of the chain via information flow and allowing the company achieves control ... by mastering the flow of information from outside companies to inside department or on connectivity in the flow of information. Alternatively, it would have been obvious to modify the virtual flows having access to the alliances at each stage to further improve the effectiveness of seamless integration, mastering the flow information and company control. Common sense would indicate that one cannot control or master anything if one can not have access to information from each agency or connection to the information flows.

**As for dep. claims 2-4, 12-14**, these are shown on page 1, line 30-35, 47, page 7, 50-55, page 8, lines 22-27.

**As for dep. claims 5-6, 15-16**, these are shown on page 1, lines 35-40, page 2, lines 1-7. Alternatively, the inclusion of other well known information of business parameter such as material/product, information, marketing and finance, etc., would have been obvious as mere monitoring other well known critical information in the virtually integrated supply chain of ARTICLE 1998.

**As for dep. claims 7, 10, 17, 20**, the provision of other business information (flow) includes financial information is shown on page 2, lines 35-40, 55-59, page 10, lines 10-14 (transaction cost information, customization costs, set-up cost, storing cost, POS data, market data, etc.) or inherently included in the business integrated supply chain of ARTICLE 1998 which normally cover manufacturing, marketing, and cost analysis. Alternatively, the inclusion of other well known financial information would have been obvious in view of the teaching of monitoring all information related to the manufacturing and selling of product as taught by ARTICLE 1998 above.

**As for dep. claims 8, 18**, this is shown in page 2, lines 5-7, 40-44, page 8, lines 20-40.

**As for dep. claims 9, 19**, the limitation of virtual regional hubs or distribution centers located regionally is taught on page 8, lines 5-10, or page 1, lines 30-40, wherein it's well known that computer parts for Dell are made throughout the world such as Taiwan, China, Malaysia, Mexico, etc., and the parts are assembled and sold in the United States and therefore, virtual regional hubs are created outside the United States to communicate effectively. Moreover, it's well known to an artisan that the degree/effectiveness of coordination/control varies with the number of alliances, the type of organization, geographical locations of each alliance (supplier or manufacturer), operating time of each alliance, etc., therefore, the adjusting of the control degree or effectiveness is considered as optimizing operating conditions or result effective variables and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and

would have been obvious to the skilled artisan. In re Aller, 105 USPQ 233. For example, if the alliances is scattered throughout the globe, i.e. China, Philippine, Europe, Africa, U.S., it would have been obvious to form regional hub to effectively coordinate the communication between the alliances due to the large distance between each alliance.

**3. Claims 7-10, 17-20 are also rejected (2<sup>nd</sup> time) under 35 U.S.C. 103(a) as being unpatentable over VAN HOEK as applied to claims 1-10, 11-20 above, and further in view of LEWIS et al (Article “Logistics and Information Technology: A Coordination Perspective”, 1997).**

The teaching of VAN HOEK is cited above.

**As for claims 7, 17,** In a similar business environment for virtual business enterprise due to outsourcing and sub-contracting and the calling for a “value-added partnerships (or strategic alliances)”, LEWIS et al is cited to control of information flows in a virtual flow train or rail wherein the information includes other well known business information such as financial flow (purchase order, waybills, and payments) to complete the management of a business transaction of a product or service (see pages 2, 3, 4, especially lines 15-20, page 5, lines 36-40, ). It would have been obvious to modify the process of VAN HOEK to include other well known financial information as taught by LEWIS et al to complete the management of a business transaction of a product/service and/or completion of the Supply Chain Management or Logistics Processes Management. Moreover, it would have been obvious to modify the process of VAN HOEK to clearly and definitively provide a plurality of virtual alliances for the



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manufacturing and distribution in view of the teaching of a “value-added partnerships (or strategic alliances)” as mentioned by LEWIS et al above.

**As for dep. claims 8, 18**, this is also shown in LEWIS et al on page 2, lines 5-15, page 4, lines 15-23.

**As for dep. claims 9, 19**, this is taught on example on LEWIS et al page 4, lines 40-45.

**As for dep. claim 10**, the limitation of the “initiation/triggering step” is taught in LEWIS et al page 4, lines 25-30 “delivery may take place”, lines 40-46 “Fedex takes care distribution or shipping”.

As for the limitation of the triggering of other well known business issue such as financial issue in dep. claims 10, 20, it would have been obvious to modify the product or service of the initiation/triggering step with financial issue such as payment of bill or waybills as mentioned earlier to complete the business transaction or mere selection of other well known business issue as shown in LEWIS et al (page 4, lines 17-22, page 5, lines 36-42).

***Response to Arguments***

4. Applicant's arguments (1) filed 07/01/2004 have been fully considered but they are not persuasive.

(1) Applicant's comment that Van Hoek fails to disclose the amended limitation of "the virtual flows having access to the virtual alliances at each stage of the manufacture and distribution of the product" is not persuasive because this is inherently included in the teachings as mentioned in (b) to achieve seamless integration of the chain via information flow and allowing the company achieves control ... by mastering the flow of information from outside companies to inside department or on connectivity in the flow of information. Alternatively, it would have been obvious to modify the virtual flows having access to the alliances at each stage to further improve the effectiveness of seamless integration, mastering the flow information and company control. Common sense would indicate that one cannot control or master anything if one can not have access to information from each agency or connection to the information flows.

Applicant's comment that Van Hoek appears to describe integration as occurring at multiple, selected points in the supply chain and not at each stage is merely applicant's opinion/interpretation and without sufficient evidence. See the paragraph above with emphasis on "seamless integration" and "company achieves control ... by mastering the flow of information from outside companies to inside department or on connectivity in the flow of information".

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or <http://pair-direct.uspto.gov>

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov) .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
December 17, 2004

  
**DEAN T. NGUYEN**  
**PRIMARY EXAMINER**